



"Express Mail" mailing number: EV 611690909 US

Date of Deposit, June 30, 2005

I hereby certify that this paper and all papers and fees referred to herein are being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. 1.10 on the date indicated above and is addressed to Attention: Office of Petitions, Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Angela L. Boyd

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Middelberg et al.

Group Art Unit: 3653

**Serial No.: 10/034,853**

Examiner: Schlak, Daniel K

Filed: December 28, 2001

Docket No. 063288-0350 (1174/117/2)

Confirmation No.: 9627

For: APPARATUS AND METHOD FOR COLLECTING FLAT AND LETTER  
UNITS

\*\*\*\*\*

**PETITION TO REVIVE APPLICATION ABANDONED UNAVOIDABLY**

Attention: Office of Petitions  
Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This Application was originally filed without Figure 6B. A Preliminary Amendment attaching Figure 6B was filed with the U.S. Patent and Trademark Office on September 23, 2004. A copy of the date-stamped postcard by the U.S. Patent and Trademark Office, indicating receipt of the Preliminary Amendment submitting Figure 6B is attached hereto as Exhibit A.

An Office Action dated April 8, 2004 was mailed by the U.S. Patent and Trademark Office confirming that the drawing filed on September 29, 2003 was accepted. A copy of the Official Action is attached.

A Notice of Allowance was mailed on October 15, 2004. The drawings were indicated as all being accepted by the Examiner. A Notice Regarding Drawings was mailed on December 2, 2004 indicating Figure 6B was missing. On December 9, 2004, a draftsman with the U.S. Patent and Trademark Office informed our office by telephone that Figure 6B had in fact been matched with the file and that no action was required. The Issue Fee was paid on December 20, 2004.

A Notice of Abandonment was mailed on April 18, 2004 indicating the application was being abandoned due to failure to submit Figure 6B. On April 26, 2005, Ms. Gaynelle Lewis of the Publications Department with the U.S. Patent and Trademark Office informed our office in a telephone conversation that the Notice of Abandonment had been mailed incorrectly and that our office just needed to file a Petition Under 37 C.F.R. §1.181(a) to Withdraw Abandonment. That Petition was filed on April 27, 2005, but our office has most recently been informed by telephone that the Petition to Withdraw the Incorrect Abandonment has been dismissed.

In light of the above, Applicant respectfully submits this Petition under 37 C.F.R. §1.137(a) to revive and submits that this Application was avoidably abandoned. In the alternative, Applicant respectfully requests that this Petition be treated as a Petition under 37 C.F.R. §1.137(b) to revive this Application as abandoned unintentionally.

Serial No. 10/034,853

DEPOSIT ACCOUNT

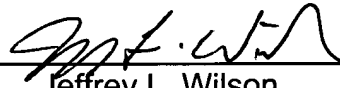
The Commissioner is hereby authorized to charge any fees associated with the filing of this correspondence to Deposit Account No. 50-0426.

Respectfully submitted,

JENKINS, WILSON & TAYLOR, P.A.

Date: June 30, 2005

By:



Jeffrey L. Wilson  
Registration No. 36,058  
Customer No. 25297

1174/117/2 JLW/alb

Enclosures



The U.S. Patent and Trademark  
Office date stamp sets forth the  
date of receipt of:

Attorney: JLW/DPG/bss  
Docket No.: 63288-0350(1174/117/2)  
Serial No.: **10/034,853**  
Applicant: Middelberg et al.

Title: APPARATUS AND METHOD FOR COLLECTING FLAT AND LETTER  
UNITS

The following items were mailed to the U.S. Patent and Trademark Office on the  
date indicated below:

1. Transmittal Letter (1 pages);
2. Amendment Transmittal Form (2 pages);
3. Preliminary Amendment (Amendment A) (4 pages);
4. Transmittal of Formal Drawings (1 page);
5. One (1) sheet of formal drawings; and
6. Return-receipt postcard to be returned to us with the U.S. Patent and  
Trademark Office filing stamp on it.

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Date Transmitted: September 25, 2003

JENKINS  
WILSON  
& TAYLOR

patent attorneys

September 25, 2003



I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on September 25, 2003.

Bonnie S. Sheridan

Date of Signature: September 25, 2003

RICHARD E. JENKINS

JEFFREY L. WILSON

ARLES A. TAYLOR, JR.

DAVID P. GLOEKLER

GREGORY A. HUNT

E. ERIC MILLS

BENTLEY J. OLIVE

CHRIS PERKINS, PH.D.\*

JAMES DALY IV, PH.D.\*\*

OF COUNSEL  
SOROJINI BISWAS

\*LICENSED ONLY IN CA

\*\*LICENSED ONLY IN NY

Mail Stop Non-Fee Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Re: U.S. Patent Application Serial No. 10/034,853 for  
APPARATUS AND METHOD FOR COLLECTING FLAT AND  
LETTER UNITS  
Our Ref. No. 063288-0350

Sir:

Please find enclosed in connection with the subject U.S. patent application the following documents:

1. An Amendment Transmittal Form;
2. A Preliminary Amendment (Amendment A)
3. A Transmittal of Formal Drawings;
4. One (1) sheet of formal drawings;
5. A return-receipt postcard to be returned to us with the U.S. Patent and Trademark Office filing stamp thereon.

The Commissioner is hereby authorized to charge any fees associated with the filing of this correspondence to Deposit Account Number 50-0426.

Respectfully submitted,

JENKINS, WILSON & TAYLOR, P.A.

Jeffrey L. Wilson  
Registration No. 36,058

JLW/DPG/bss  
Enclosures  
Customer No: 25297

tel 919.493.8000  
fax 919.419.0383

Jenkins, Wilson & Taylor, P.A.  
JenkinsWilsonTaylor.com

University Tower, Suite 1400 | 3100 Tower Boulevard | Durham, North Carolina 27707



Practitioner's Docket No. 063288-0350

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Middelberg et al.

Application No.: 10/034,853  
Filed: 12/28/2001

Group No.: 3651  
Examiner: Not Assigned

For: APPARATUS AND METHOD FOR COLLECTING FLAT AND LETTER UNITS

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

AMENDMENT TRANSMITTAL

1. Transmitted herewith is an amendment for this application.

STATUS

2. Applicant is other than a small entity.

EXTENSION OF TERM

3. The proceedings herein are for a patent application and the provisions of 37 C.F.R. 1.136 apply. Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition for extension of time.

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**CERTIFICATION UNDER 37 C.F.R. §§ 1.8(a) and 1.10\***

*(When using Express Mail, the Express Mail label number is mandatory;  
Express Mail certification is optional.)*

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37 C.F.R. § 1.8(a)

■ with sufficient postage as first class mail.

37 C.F.R. § 1.10\*

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**TRANSMISSION**

☐ facsimile transmitted to the Patent and Trademark Office, (703) \_\_\_\_\_ - \_\_\_\_\_

Bonnie S. Sheridan  
Signature

Date: September 25, 2003

Bonnie S. Sheridan

*(type or print name of person certifying)*

\* Only the date of filing (§ 1.6) will be the date used in a patent term adjustment calculation, although the date on any certificate of mailing or transmission under § 1.8 continues to be taken into account in determining timeliness. See § 1.703(f). Consider "Express Mail Post Office to Addressee" (§ 1.10) or facsimile transmission (§ 1.6(d)) for the reply to be accorded the earliest possible filing date for patent term adjustment calculations.

## FEE FOR CLAIMS

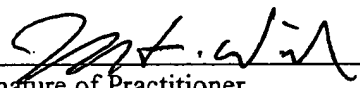
4. The fee for claims (37 C.F.R. 1.16(b)-(d)) has been calculated as shown below:

	(Col. 1)	(Col. 2)	(Col. 3)	OTHER THAN A SMALL ENTITY				
	CLAIMS REMAINING AFTER AMENDMENT	HIGHEST NO. PREVIOUSLY PAID FOR	PRESENT EXTRA			RATE		ADDIT. FEE
TOTAL	76	-	76	=	0	x	\$ 18.00	= \$ 0.00
INDEP.	6	-	6	=	0	x	\$ 84.00	= \$ 0.00
FIRST PRESENTATION OF MULTIPLE DEP. CLAIM						+	\$ 0.00	= \$ 0.00
							TOTAL ADDIT. FEE	\$ 0.00

No additional fee for claims is required.

Date: September 25, 2003

Reg. No.: 36,058  
Tel. No.: 919-493-8000  
Customer No.: 25297

  
 Signature of Practitioner  
 Jeffrey L. Wilson  
 Jenkins, Wilson & Taylor, P.A.  
 Suite 1400 University Tower  
 3100 Tower Boulevard  
 Durham, NC 27707



I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on September 25, 2003.

PATENT

Bonnie S. Sheridan  
Bonnie S. Sheridan  
Date of Signature September 25, 2003

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Middelberg et al.

Group Art Unit: 3651

Serial No.: 10/034,853

Examiner: Not Assigned

Filed: December 28, 2001

Docket No.: 063288-0350

Confirmation No.: 9627

For: APPARATUS AND METHOD FOR COLLECTING FLAT AND LETTER  
UNITS

\*\*\*\*\*

PRELIMINARY AMENDMENT

Mail Stop Non-Fee Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Please amend the above-reference application as follows:



Serial No.: 10/034,853

IN THE DRAWINGS:

Please add Figure 6B, attached hereto.

Serial No.: 10/034,853

## REMARKS

### Drawings

The official publication of the present application, U.S. Patent Application Pub. No. US 2003/0085512 A1, is missing Figure 6B. Though the return postcard received by Applicants in the present application, date stamped by the PTO on December 28, 2001, indicates that the application was originally filed with 18 drawing sheets (which is the complete number of original drawing sheets), it is not known for certain whether original Figure 6B was actually omitted from the original filing package or misplaced from the official record. As such, a true copy of Figure 6B intended to have been filed with the original application is attached herewith for entry into the record of the present application.

Applicants note that no new matter will be added as a result of entry of Figure 6B. Figure 6B is fully described and referenced in the application as originally filed and is part of a sequence of drawings, Figures 6A, 6B and 6C, depicting various stages of operation of the same apparatus. Each of Figures 6A, 6B and 6C are substantially similar to the other drawings in this sequence, and contain the same elements. The primary difference between Figures 6A, 6B and 6C is the location of certain elements relative to other elements. The descriptions of the apparatus as shown in each of Figures 6A, 6B and 6C, and the differences between Figures 6A, 6B and 6C, are clearly and expressly

Serial No.: 10/034,853

provided in the written description of the application as originally filed, particularly at p. 13, lines 4-12.

Accordingly, it is respectfully requested that Figure 6B be entered at this time.

DEPOSIT ACCOUNT

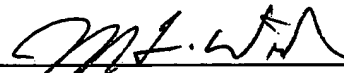
The Commissioner is hereby authorized to charge any fees associated with the filing of this correspondence to Deposit Account No. 50-0426.

Respectfully submitted,

JENKINS, WILSON & TAYLOR, P.A.

Date: September 25, 2003

By:

  
Jeffrey L. Wilson  
Registration No. 36,058

1174/117/2

JLW/bss

Customer No: 25297

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PATENT

Bonnie S. Sheridan  
Bonnie S. Sheridan  
Date of Signature September 25, 2003

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Middelberg et al.

Group Art Unit: 3651

**Serial No.: 10/034,853**

Examiner: Not Assigned

Filed: December 28, 2001

Docket No.: 063288-0350

Confirmation No.: 9627

For: APPARATUS AND METHOD FOR COLLECTING FLAT AND LETTER  
UNITS

\*\*\*\*\*

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450  
Attention: Official Draftsman

TRANSMITTAL OF FORMAL DRAWINGS

Dear Sir:

Please find enclosed a new drawing, Figure 6B (1 sheet) for filing in the above-identified U.S. Patent Application.

Although it is believed that no fee is due, the Commissioner is hereby authorized to charge any fees associated with the filing of this correspondence to Deposit Account Number **50-0426**.

Respectfully submitted,

JENKINS, WILSON & TAYLOR, P.A.

Date: September 25, 2003

By:

Jeffery L. Wilson  
Jeffery L. Wilson  
Registration No. 36,058

JLW/DPG/bss  
Enclosures  
Customer No: 25297



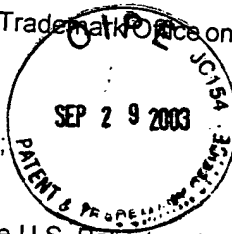
The U.S. Patent and Trademark  
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Attorney: JLW/DPG/bss  
Docket No.: 63288-0350(1174/1172)  
Serial No.: 10/034,853  
Applicant: Middelberg et al.

Title: APPARATUS AND METHOD FOR COLLECTING FLAT AND LETTER  
UNITS

The following items were mailed to the U.S. Patent and Trademark Office on the  
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1. Transmittal Letter (1 pages);
2. Amendment Transmittal Form (2 pages);
3. Preliminary Amendment (Amendment A) (4 pages);
4. Transmittal of Formal Drawings (1 page);
5. One (1) sheet of formal drawings; and
6. Return-receipt postcard to be returned to us with the U.S. Patent and  
Trademark Office filing stamp on it.



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Date Transmitted: September 25, 2003

OCT - 3 2003

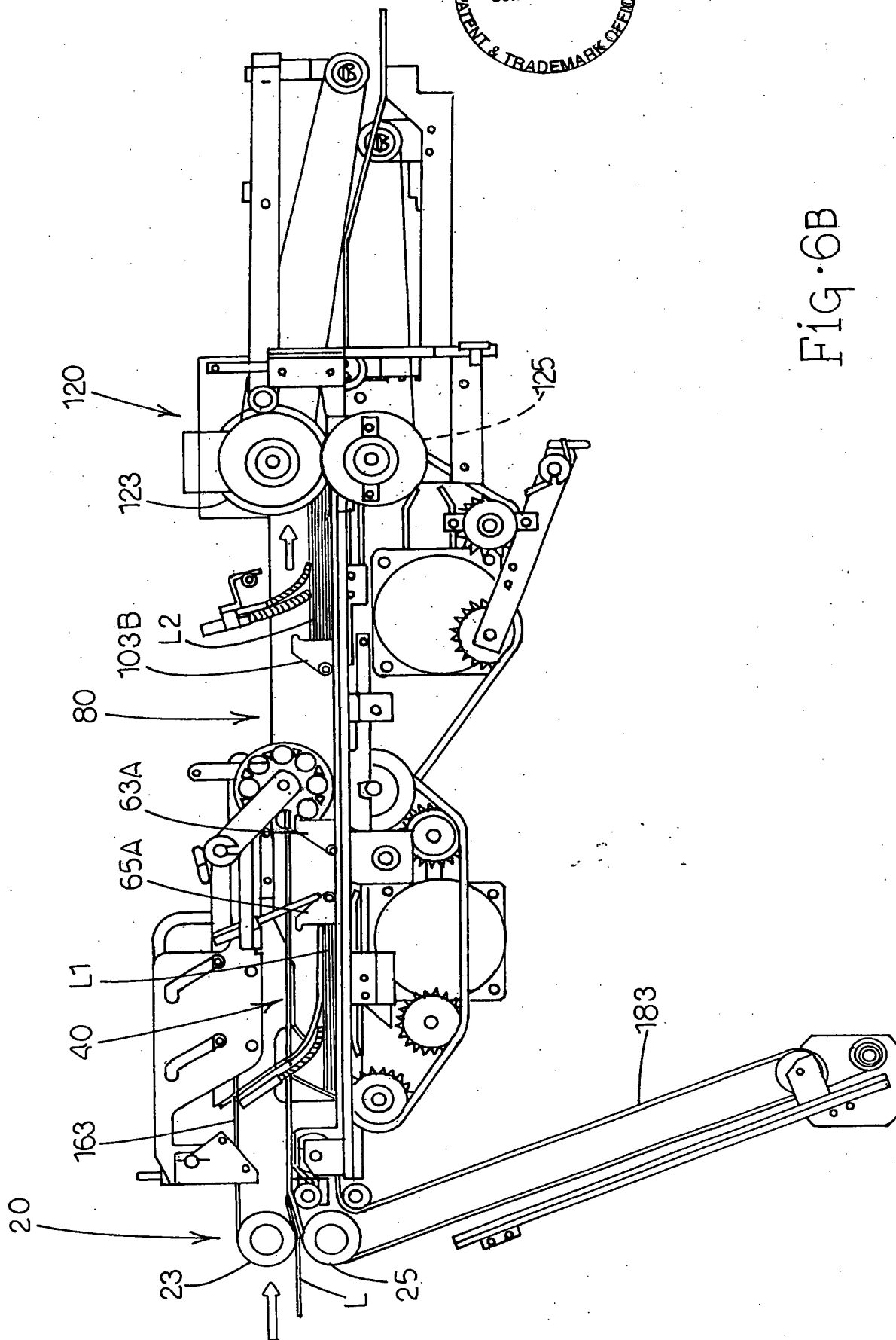


Fig. 6B



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/034,853	12/28/2001	Neal J. Middelberg	1174/1172	9627

25297 7590 04/08/2004

JENKINS & WILSON, PA  
3100 TOWER BLVD  
SUITE 1400  
DURHAM, NC 27707



APR 19 2004

EXAMINER

SCHLAK, DANIEL K

ART UNIT PAPER NUMBER

3653

DATE MAILED: 04/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

DOCKET DATES: 7/8, 9/8, 9/8, 10/8/04  
ASSIGNED ATTY: JLW  
FILE NO. 1174/1172  
DOCKETED BY: HMP  
DATE: 4/20/04



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/034,853	12/28/2001	Neal J. Middelberg	1174/117/2	9627

25297 7590 04/08/2004

JENKINS & WILSON, PA  
3100 TOWER BLVD  
SUITE 1400  
DURHAM, NC 27707

EXAMINER

SCHLAK, DANIEL K

ART UNIT	PAPER NUMBER
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3653

APR 19 2004

DATE MAILED: 04/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



# Office Action Summary

Application No.

10/034,853

Applicant(s)

MIDDELBERG ET AL.

Examiner

Daniel K Schlak

Art Unit

3653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-76 is/are pending in the application.
- 4a) Of the above claim(s) 34-76 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22, 25-33 is/are rejected.
- 7) ☒ Claim(s) 23 and 24 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

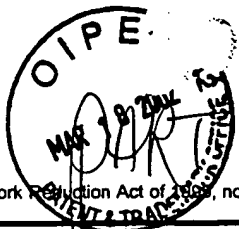
## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4,6,11.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.



COPY OF PAPER  
ORIGINALLY FILED

PTO/SB/08A (10-01)

Approved for use through 10/31/2002. OMB 0651-0031  
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

<b>Substitute for form 1449A PTO</b>  <b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b>  (use as many sheets as necessary)			<b>Complete if Known</b>	
			<b>Application Number</b>	10/034.853
			<b>Filing Date</b>	12/28/2001
			<b>First Named Inventor</b>	Neal J. Middelberg
			<b>Art Unit</b>	
			<b>Examiner Name</b>	
			<b>Attorney Docket Number</b>	1174/117/2
<b>Sheet</b>	1	<b>of</b>	1	

U.S. PATENT DOCUMENTS					
Examiner Initials*	Cite No. <sup>1</sup>	Document Number	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		Number - Kind Code <sup>2</sup> (if known)			
JS	01	US- 5,899,453	05/04/1999	Middelberg et al.	<b>RECEIVED</b>  APR 13 2002  GROUP 3600
JS	02	US- 5,806,659	09/15/1998	Middelberg et al.	
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FOREIGN PATENT DOCUMENTS						
Examiner Initials*	Cite No. <sup>1</sup>	Foreign Patent Document	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	T <sup>6</sup>
		Country Code <sup>3</sup> -Number <sup>4</sup> -Kind Code <sup>5</sup> (if known)				

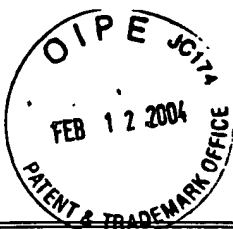
<b>Examiner Signature</b>		<b>Date Considered</b>	4/4/04
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\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

<sup>1</sup> Applicant's unique citation designation number (optional). <sup>2</sup> See Kinds Codes of USPTO Patent Documents at [www.uspto.gov](http://www.uspto.gov) or MPEP 901.04. <sup>3</sup> Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). <sup>4</sup> For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. <sup>5</sup> Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. <sup>6</sup> Applicant is to place a check mark here if English language Translation is attached.

Burden Hour Statement: This form is estimated to take 2.0 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

**Burden Hour Statement:** This form is estimated to take 2.0 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. **DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.**



Part of Paper #11

SHEET 1 OF 1

<b>INFORMATION DISCLOSURE CITATION IN AN APPLICATION</b>  (PTO-1449)	<b>ATTY. DOCKET NO.</b> 63288-350	<b>SERIAL NO.</b> 10/034,853
	<b>APPLICANT</b> Neal J. MIDDLEBERG, et al.	
	<b>FILING DATE</b> December 28, 2001	<b>GROUP</b> 3653

**U.S. PATENT DOCUMENTS**

EXAMINER'S INITIALS	CITE NO.	Document Number Number-Kind Code <sup>2</sup> (if known)	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		US 5,699,453	05/04/1999	Middelberg et al.	Duplicate - already submitted in paper #4
ds		US 5,634,551	06/03/1997	Francioni et al.	
ds		US 4,541,764	09/17/1985	Govan et al.	
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		US			
		US			

**FOREIGN PATENT DOCUMENTS**

EXAMINER'S INITIALS	CITE NO.	Foreign Patent Document Country Codes - Number - Kind Codes (if known)	Publication Date YYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines Where Relevant Figures Appear	Translation	
						Yes	No
ds		EP 0 455 494 A2	11/06/1991	PITNEY BOWES INC.			

**OTHER ART (Including Author, Title, Date, Pertinent Pages, Etc.)**

EXAMINER'S INITIALS	CITE NO.	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.

<b>EXAMINER</b> 	<b>DATE CONSIDERED</b> 4/4/04
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\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered.

Include copy of this form with next communication to applicant.

1 Applicant's unique citation designation number (optional). 2 Applicant is to place a check mark here if English language Translation is attached.

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FEB 19 2004  
**GROUP 3600**

## **DETAILED ACTION**

### ***Election/Restrictions***

Claims 34-76 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Groups II-VI, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 10.

Applicant alleges that the restriction between Group I and Group II should have been under combination/subcombination and not subcombinations usable together. Following the allegation, "subcombinations usable together would be proper if the claim groups recited entirely different elements which are usable together. However, this does not apply." It does apply. One group has rotatable elements, the other does not. The other has a third staging area, the one does not. The rotatable elements and the third staging area are not mutually exclusive. When a Group (A, for instance) has a feature a1, and Group B has feature b1, and b1 is not in A and a1 is not in B, then the situation is one of subcombinations usable together. It can always also be argued that the relationship is of combination-subcombination, but this is more a matter of point-of-view than of precedent or fact. Perhaps, in this case, Group I might be a combination over Group II, or perhaps Group I is the subcombination. Regardless, the Examiner made sure to meet the criteria for combination-subcombination as well as those for subcombinations usable together, so that in the event that an argument were to be made that one group were much more broad than the other, the actual separability of

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the groups would not be affected. In other words, two-way distinctness was demonstrated. Each has its own element, not mentioned in the other. Each has its own utility, put forth in lines 1 and 2 of page 3 of the prior action. In fact, the only way that Applicant could maintain that Group I and Group II are not distinguishable would be to state on the record that the third staging area *is in fact* the rotatable elements.

Applicant further alleges that the supposedly required combination/subcombination restriction requires a showing that the combination does not require the particulars of the subcombination and that the subcombination can be shown to have utility in other and different relations. However, the Examiner cannot even tell from the Applicant's arguments *which* is the combination and which is the subcombination. Certainly Group I does not require rotatable elements, and Group II does not require a 3<sup>rd</sup> staging area. Both groups can be shown to have utilities by themselves (as described already), and both can be shown to have different relations, such as one has a 3<sup>rd</sup> staging area and one has rotatable elements. The rotatable elements don't just levitate in space, and the 3<sup>rd</sup> staging area might be just about anything so long as it comprises a bit of the 2<sup>nd</sup>.

The Examiner, according to Applicant, does not provide a meaningful explanation of separate utility. Applicant is reminded that the Examiner cannot possibly write two or three pages on the possible utilities of different groups, when a simple and believable statement can be made to show the difference. How could two groups, one with an extra surface and the other with rotating elements, *not* find different utilities? The extrapolations are endless, and there is no need to dilute the subject matter of the

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action postulating what might be done with each one. Perhaps the rotating elements press the water out of every fifth passing item and perhaps the 3<sup>rd</sup> staging area is used to set up a doll house. The Examiner does not have the time nor the resources to expound on every restriction requirement when the separate elements are obviously distinctly claimed and shown in the drawings.

As pertains to the arguments against the separation of Groups III and II, applicant argues that the fact that the subcombination may operate without the upstream device does not establish separate utility from the combination. So, the idea that Group II might and quite possibly *could* have a ream of paper sitting in the first staging area, conveying sheets from the ream instead of from an upstream device, has no pertinence to the utility of an upstream device? This allegation is groundless.

As pertains to the arguments against the separation of Groups IV and I, it has been purported that the Examiner has changed the claim language. The Examiner has no intention of changing claim language. If Applicant will kindly turn to claim 51 and read a few lines, it was the claims themselves which provided the movement of the adjustable conveying member. The Examiner's assertion was that, although claim 1 is mentioned as adjustable, certainly it can be used without adjustments being made. In fact, perhaps days could pass without adjusting the collector of claim 1. How then could Applicant say that the Examiner has not shown that the conveying device could be used to practice another and materially different process? The materially different processes are a) one in which the conveying element is moved and b) another in which movement does not take place.

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As pertains to the arguments against the separation of Groups V and I, applicant alleges that it is irrelevant that the "method can be used to transport stacks." This was added by the Examiner to re-enforce the separability, and in no way negates the existence of the next line, wherein the Examiner gave due example of the "another materially different apparatus" that may be used for the process claimed, namely, one that has no adjustable element. At the top of page 5 of the response, Applicant alleges that the Examiner states that the apparatus of Group 1 "can be used in an environment with no moving of an adjustable element." This, Applicant states, means that the element is stationary, and that the assertion by Examiner does not correspond to the claims of Group 1. However, if Applicant will kindly read over again the quoted passage, the Examiner never said that Group V could be used without the adjustable element. The Examiner only said that the invention of Group V could be used without the movement of an adjustable element. As Applicant stated just a few pages earlier, it behooves no one involved to put words into each other's mouths. Claim 1 can be used *without adjusting* and therefore would not be performing the method of Group V.

As pertains to Groups III and II, applicant states that Examiner must allege some other purpose which the subcombination itself as claimed would have separate utility. This has already been done, when the Examiner stated that the subcombination could operate without an upstream device. If the subcombination were used without an upstream device, it would have to have its own source of fed items. This, it seems, would be quite a different device than one which requires an upstream device.



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As pertains to the restriction requirement between Groups IV and III and Groups V and III, both on the grounds that the process is different from the apparatus, Applicant is directed to the above paragraph, wherein it has been shown too many times already that a sheet-feeding device operating without an upstream device finds example in itself, by offering the potential aspect of being its own source of material. The Examiner is not going to find art, or draw pictures, to give evidence that another embodiment is viable. If this were the requirement, restriction would be useless. When the Examiner offers the scenario of an embodiment capable of use without an item, the suggestion automatically conveys the idea of the materially different device or method which could be conceived, and the "reasonable examples" have been provided. The fact that a process can be practiced without an element of the apparatus does not show any material difference. How could this *ever* be said? How is a device, minus one of its potentially patentable features, not a materially different device? Applicant is reminded that restriction is made before the art is of record, and therefore all elements of a claim are initially conceived as bearing potential patentability. If a device comprises elements A, B, C, and D, and then a method comprises using A, B, and C, unquestionably the device without D is a different device. In other words, the omission of an element is just as substantial as the addition of an element in creating a device.

As pertains to the restriction requirement between Groups IV and II and Groups V and II, Applicant repeats that it is up to the Examiner to provide reasonable examples. The Examiner asserts that a claim for a device omitting an element is a claim for a different device. Later comes into question the burden upon the Examiner. The

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Examiner has already deemed it undue and refuses to re-group these claims. As the grounds for restriction are proper, there will be no retraction of the restriction requirement. How does Applicant know what a reference found by the Examiner might or might not comprise? The Examiner's shoes don't have rotatable elements, and not surprisingly they would be found during a search on the apparatus but unfortunately do not read on the process

As pertains to Groups IV and V, Applicant alleges that, because the Groups comprise similar subject matter, they cannot be subcombinations usable together. If they had *no* common elements, they would be divergent subject matter. A claim with A, B, and C is restrictable from a claim with A, B, and D. This is the nature of the subcombinations usable together, and the Examiner has shown C and D for the pair of groups. If Applicant feels every claim should be restricted, it is no business of the Examiner's. Claims to be searched together will have the same base elements and will not diverge after A and B. Groups IV and V have adequate distinction in elements, such as Group V doesn't even mention a flats position and Group IV doesn't mention at all transporting a letter to the second staging area, although this is important to Group V. How could these claims be seen as belonging together?

The same follows for the restriction between Groups VI and I. Although no direct allegation has been made, Applicant repeats the assertion that practicing a process without an element of an apparatus does not show any difference to practicing it with the original apparatus. This has been shown to be not true. If the element is unimportant, let it be left out. If it is important, then it should be left in.

The method, by failing to mention the element, opens up the search and the scope of the art to be applied considerably, and it is not for the Examiner nor is it for the Applicant to predict what might be found in a search. Different elements in different claims send a searcher down different paths, and given that most claims begin with anywhere from 70% to 90% of art-known structural limitations, followed by a few lines of what the Applicant considers patentable, small things count a lot and they can have everything to do with the search and the burden is to be deemed undue or acceptable by the Examiner and not by the Applicant and it has been deemed undue and therefore no claims will be re-joined at any point save they be made to resemble adequately other claims with which it is sought to rejoin them.

The Examiner believes the refutation of the foregoing arguments adequately refute as well the arguments of pages 9 and 10 of the response. Again, an apparatus minus an element, considering the element was important enough to put forth in a claim, is inherently a materially different apparatus.

In summary, all arguments concerning the provisionally elected Group I have been countered directly, and the divisibility via restriction of Groups VI and III, Groups VI and II, Groups VI and IV, and Groups VI and V, indirectly via prior arguments.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 6, 11, 12, 16-22, 25-29, and 31-33 are rejected under 35 U.S.C. 102(b) as being anticipated by US 4,219,191 to Rastorguyeff.

Rastorguyeff teaches a collector apparatus adapted for handling flat and letter units, the apparatus comprising a first staging area comprising a first staging surface and a first stage transport assembly, a second staging area generally disposed downstream from the first staging area, the second staging area comprising a second staging surface and a second stage transport assembly, a third staging area comprising at least a portion of the second stage transport assembly, and a conveying device adjustable between a flats mode position and a letters mode position, wherein in the letters mode position, a first material flow path is defined through the first and second staging areas, and in the flats mode position, a second material flow path is defined through the third staging area. The first stage transport assembly comprises a movable first endless member. The second stage transport assembly comprises a second endless member. The conveying device comprises a retractable first conveying assembly, the retractable first conveying assembly is extended over at least a portion of the first staging surface in the flats mode position of the conveying device, and the retractable first conveying assembly is retracted to expose the first staging surface in the letters mode position. The retractable first conveying assembly comprises a

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movable first endless belt, the movable endless belt is extended over at least a portion of the first staging surface in the flats mode position of the conveying device, and the movable first endless belt is retracted to expose the first staging surface in the letters mode position.

An input device operatively communicates with an upstream end region of the first staging area in the letters mode position, and operatively communicates with an upstream end region of the third staging area through the conveying device in the flats mode position. The retractable first conveying assembly comprises a first rotatable element, the first rotatable element disposed at an upstream end region of the first staging area in the letters mode position, and alternatively disposed at a downstream end region of the first staging area in the flats mode position. The retractable first conveying assembly comprises a first endless belt movable about the first rotatable element. The retractable first conveying assembly comprises a second rotatable element disposed at first elevation in the letters mode position, and alternatively disposed at a second elevation in the flats mode position, and wherein the second elevation is higher than the first elevation. The retractable first conveying assembly comprises a first endless belt movable about the first and second rotatable elements. The conveying device comprises a second conveying assembly, the first conveying assembly includes a movable first endless belt, the second conveying assembly includes a movable second endless belt, and the second material flow path runs between the first and second endless belts. An input device operatively communicates

with an upstream end region of the first staging area in the letters mode position, and operatively communicating with an upstream end region of the third staging area through the first and second endless belts in the flats mode position.

The conveying device comprises a material unit guiding component adjustable between the flats mode position and the letters mode position, and wherein, in the letters mode position, the guiding component is disposed at a first elevation at which the guiding component is adapted to at least partially define the first material flow path, and in the flats mode position, the guiding component is disposed at a second elevation higher than the first elevation.

The conveying device comprises a material unit guiding component adjustable between the flats mode position and the letters mode position, and wherein, in the letters mode position, the guiding component is disposed at a first elevation at which the guiding component is adapted to at least partially define the first material flow path, and in the flats mode position, the guiding component is disposed at a second elevation higher than the first elevation. The apparatus further comprises an input device an upstream end region of the first operatively communicating with staging area in the letters mode position, and operatively communicating with an upstream end region of the third staging area through the conveying device in the flats mode position. The input device is supposed by an upstream material unit processing device. An output device is taught operatively communicating with a downstream end of the second staging area.

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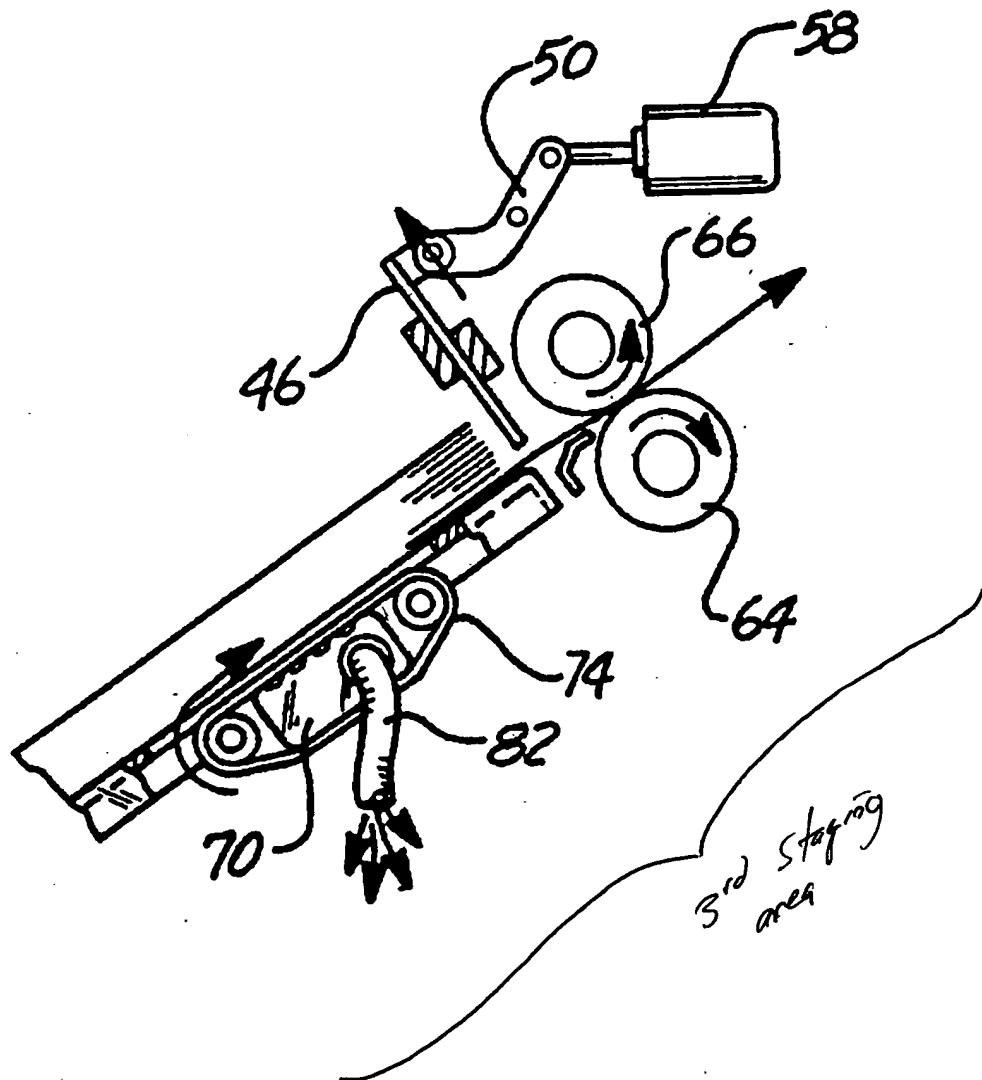
The following two pages comprise excerpts from the reference, namely figures 1 and 2 of Rastorguyeff, to aid applicant in understanding the nature of the rejection.

Figure 2 has been included to show the extent of the third staging area.





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Claims 1-18 and 26-33 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,899,453 to Middleberg et al.

Surely Applicant is familiar with this reference. The only point of contention, as most of the device is almost exactly the same as the device of the instant application, should be whether or not there is a conveying device adjustable between flats mode and letters mode, wherein in letters mode a first flow path is defined, and in the flats mode a second flow path is defined. The Examiner asserts that, as there is no claim limitation *in the claims rejected here* that further defines the device in a way that does not read on '453. The Examiner asserts that elements 50A and 52A of figure 3 teach a retractable first conveying assembly which is adjustable (it swings on the arm for adjustments up and down) to change the flow path.

In both rejections under 35 U.S.C. 102, Applicant is reminded that the third staging area, in the instant application and in the references, is nothing more than most of the first staging area and part or most of the second staging area. No liberties have been taken in interpreting it thus, as Applicant has done exactly this. Thus, no matter what the flow path, it necessarily passes through all three flow paths all the time. The movable/retractable first conveying assembly, and what it comprises or how it acts, does not change the existence of the staging areas and how they are interpreted, particularly since the instant application is an improvement on '453. In other words, since '453 teaches everything of the claims rejected under it, including a retractable first conveying assembly that is shown clearly capable of adjustment up and down, one of

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the positions (flats) finds the assembly higher and/or retracted, and the other (letters) lower. In the flats position the movable endless belt of the retractable first conveying element extends over a portion of the first staging surface, and in the letters mode it is "retracted", that is, pulled away from the flow path to expose the first staging surface.

In other words, the retractable first conveying assembly of the claims must be further defined to not read on the adjustable elements (52A, 52B, 52C) of the '453 reference, and the flow paths and/or staging areas must be further defined to not read on Rastorguyeff.

Other than the nature of the third flow path in Rastorguyeff, and the nature of the retractable first conveying assembly, Examiner trusts that the remainder of the elements in each reference will speak for themselves, as they are clearly shown and described in the references.

### ***Allowable Subject Matter***

Claims 23 and 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Rastorguyeff does not teach biasing the rotatable elements toward one elevation or another with a biasing component.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel K Schlak whose telephone number is 703-305-0885. The examiner can normally be reached on Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald Walsh can be reached on 703-306 - 4173. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

dkS

DONALD P. WALSH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600

**Notice of References Cited**

Application/Control No.

10/034,853

Applicant(s)/Patent Under  
Reexamination  
MIDDELBERG ET AL.

Examiner

Daniel K Schlak

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**U.S. PATENT DOCUMENTS**

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A	US-5,044,623	09-1991	Munz et al.	271/223
	B	US-5,016,867	05-1991	Kamath, Venkatesh H.	271/209
	C	US-5,087,026	02-1992	Wyer, Andrew F.	271/188
	D	US-3,601,265	08-1971	Shields, Albert F.	414/789.1
	E	US-997,041	07-1911	Name not available	271/188
	F	US-5,609,335	03-1997	Parker, Rebecca L.	271/302
	G	US-3,231,100	01-1966	FAEBER HARRY W	414/788.2
	H	US-3,409,148	11-1968	SHIELDS ALBERT F	414/790.3
	I	US-4,767,115	08-1988	Garthe, Matthias	271/223
	J	US-5,096,177	03-1992	Saeki et al.	271/3.05
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	M	US-4,925,362	05-1990	Golicz, Roman M.	414/790.7

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	N	5-124764	05-1993	JP	Saito et al.	271/207
	O	59-128153	07-1984	JP	Hanasaki et al.	271/5
	P					
	Q					
	R					
	S					
	T					

**NON-PATENT DOCUMENTS**

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

\*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)  
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

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	B	US-4,219,191	08-1980	Rastorguyeff, Andrew W.	271/3.07
	C	US-			
	D	US-			
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

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